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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,307	04/13/2005	Kenji Suzuki	270484USPCT	6324
22850 7590 04/29/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
MULLS, JEFFREY C				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
04/29/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/531,307

Applicant(s)

SUZUKI ET AL.

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 6,414,059).

Patentees disclose a composition containing up to 55% block copolymer, 0-40% softener and 5-80% acrylate rubber. Note the paragraph bridging columns 4 and 5. The aromatic block may be formed from vinyl toluene at column 9, lines 40-45. Note that the ingredients a-f are "micro-disperse(d)" and would thus encompass "island(s)" while the remainder of the composition would encompass a "sea" phase as the remaining components would be the continuous, not micro dispersed phase. Since the composition of the patent and instant claims are similar, similar characteristics are assumed inherent.

There are no examples in the patent of compositions having the specific combination of limitations of applicants although such falls within the broad ambit of the patent. Hence to choose applicants combination of materials from the patent would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results, absent any showing of surprising or unexpected results.

Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chundry et al. (US 5,317,059).

Patentees disclose a blend containing an acrylate polymer "III" (Abstract) and a block copolymer may contain butadiene and alkylstyrene monomer. The material is abrasion resistant at column 8, lines 26-55 and therefore presumed to have applicants characteristics of claim 2. Note also column 13, lines 43-52 where it is disclosed that a dispersed phase is present in a continuous phase (such as is encompassed by the term "sea island").

There are no examples in the patent of compositions having the specific combination of limitations of applicants although such falls within the broad ambit of the patent. Hence to choose applicants combination of materials from the patent would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results, absent any showing of surprising or unexpected results.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 7,247,674. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the two sets of claims overlap.

Applicant's arguments filed 1-17-08 have been fully considered but they are not persuasive.

With regard to unexpected results as well as to whether applicants abrasion resistance characteristic is inherent in the remaining references relied upon, Applicants comparative examples bear almost no resemblance to the examples of the prior art and thus cannot be said to be probative of either issue. For instance '059 uses a major amount of inorganic such as would be expected to confer very high abrasion resistance and such is not excluded by the claims. In fact so much inorganic is present it would not even appear that patentees organic resins would have much effect on abrasion. Also applicants use substantial amounts of oil such is not required by the claims and in general not used by the references and addition of oil is known to eventually (if added in large enough amounts) to result in a gelatinous material such as would be expected to have negligible abrasion resistance. It is noted that the only references currently relied upon explicitly disclose high abrasion resistance and such would therefore be assumed inherent when operating within the disclosure of the references. Similarly applicants have failed to present any comparative examples which are examples of Chundry. With

regard to applicants "sea-island" limitation, this morphology can be broadly construed as one in which a disperse phase ("island" phase) is present in a continuous phase ("sea") such is commonly encountered (see Aoki US 5380616 at the paragraph bridging columns 1 and 2) in blends of incompatible polymers. Those skilled in the art would therefore assume that a sea island morphology would result from operation within the disclosure of the references. In any case such a morphology is disclosed explicitly by Chundry at column 13, lines 46-52. Applicants argue that "alkylstyrene requires that the alkyl group be attached directly to the benzene ring" but the term "directly" appears nowhere in the claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075, M-F, 9-5pm.

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Jeffrey C. Mullis
Primary Examiner
Art Unit 1796

/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796